

U.S. Pat. App. Ser. No. 10/621,897
Docket No. 056754/0119588
Amendment and response to 7/14/2006 Office Action

REMARKS

Claims 1-22 are pending in the application. Claims 1 and 12-22 are subject to restriction and have been withdrawn. In the Office Action mailed July 16, 2006, claims 2-11 are rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite. Claim 5 is rejected under 35 U.S.C. 101 as allegedly having a recitation of a use without setting forth any steps involved in the process. Claims 3-11 are rejected as being dependent upon a rejected base claim.

As a preliminary matter, the Applicants note that the instant rejections are all with respect to the form of the claims and yet, despite the requirements of 37 CFR 1.104(b) and MPEP 707.07(g) requiring the development of as many issues as possible in each Office Action and prohibiting "piecemeal examination", which practice is reinforced by the requirements of MPEP 2106 ("Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility") and which the Applicants have further observed to be the universal practice of the Office, the instant Office Action neither goes on to evaluate the substantive aspects of the claims under 35 U.S.C. 102 and 35 U.S.C. 103 nor alternatively indicates that the claims are otherwise allowable. The Applicants therefore respectfully anticipate receipt of either a NonFinal Office Action on the merits or a Notice of Allowance from the Examiner in due course.

I. Rejections under 35 U.S.C. 112, second paragraph

Claims 2-11 are rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite. In particular, claim 7 is rejected as being indefinite for reciting the phrase "and other molecules of that family". The Applicants have herein amended claim 7 to remove the phrase. No new matter is added by this amendment. Entry of the amendment and withdrawal of the rejection of claim 7, as amended, is respectfully requested.

Claim 2 is rejected as being indefinite for reciting "A method for replicating a monolayer" without, allegedly, reciting any method steps requiring/defining replication of the monolayer. The Applicants respectfully traverse the Examiner's rejection. The Applicants' claim 2 clearly recites five steps defining the replication of a monolayer, the third step of which ("binding the plurality of monomers to the template") clearly recites the effect of "forming a monolayer replicant". The last two steps go on to recite steps directed to the subprocess of removing the replicated monolayer from the template. The Applicants are therefore unable to determine from whence the Examiner's objection arises, unless the Examiner is objecting to the

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use of the term "monolayer replicant" instead of the interchangeable term "replicated monolayer". If so, and the Examiner in fact feels that the term "monolayer replicant" is indefinite or otherwise undefined, the Applicants respectfully request that the Examiner make the proper objection on that basis rather than the present improper rejection that the Applicants' claim does not recite steps required to define "A method for replicating a monolayer", which rejection is clearly unfounded. The Applicants respectfully submit, however, that any such objection to the term "monolayer replicant" would be similarly unfounded, as the term "replicant" is commonly used to refer to a replicated item in the art of the Applicants' invention, the terms "X replicant" and "replicated X" are used interchangeably by those of ordinary skill in the art of the invention, and the meaning of the Applicants' term is therefore perfectly clear to one of ordinary skill in the art. Reconsideration and withdrawal of the rejection of claim 2 is therefore respectfully requested.

Because claims 3-11 depend from independent claim 2, which is in condition for allowance as discussed in the foregoing paragraph, claims 3-11 are also in condition for allowance. Reconsideration and withdrawal of the rejection of claims 3-11 is therefore respectfully requested.

II. Rejections under 35 U.S.C. 101

Claim 5 is rejected for allegedly presenting a claimed recitation of a use without setting forth any active, positive steps delimiting how the use is practiced. The Applicants respectfully traverse the Examiner's rejection. Despite the Applicants' use of the word "using", claim 5 does not recite a "use" without any steps. Rather, claim 5 recites a step, the step of creating at least one additional polymerized monolayer replicant according to the steps of claim 2, using the previously created replicant as the template recited by claim 2.

Mere use of the word "using" in a claim does not make the claim unpatentable, rather it is the absence of steps that is inherent in a prohibited "use" claim that makes the claim unpatentable. If the Applicants' claim 5 read "The method of claim 2, further including the step of using the polymerized monolayer replicant", then it would be a prohibited "use" claim, because it then would not set forth any active steps. However, the Applicants claim 5 does not read that way but rather goes on to add the necessary language to create a patentable step, "as a template for creation of at least one additional polymerized monolayer replicant". The Applicants could have, alternatively, written claim 5 to recite "The method of claim 2, wherein

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the template is a previously-created monolayer replicant" with effectively the same meaning, or could have chosen to recite the step as "using the polymerized monolayer replicant as the template, creating at least one additional polymerized monolayer replicant according to the process of claim 2."

While the Applicants believe that, as discussed in the foregoing paragraph, the Applicants' claim 5 properly recites a claimed step that is not a "use" without any active, positive steps delimiting how the use is practiced, the Applicants have herein amended claim 5 so as to reorder the words of the claim in order to make this perfectly clear. This amendment does not change the scope of the claim, but rather merely re-orders the words of the claim in order to further render impossible the incorrect interpretation given to the claim in the instant Office Action. No new matter is added by this amendment. Entry of the amendment and withdrawal of the rejection of claim 5, as amended, is therefore respectfully requested.

III. Conclusion

Claims 1-22 are pending in the application. Claims 1 and 12-22 are subject to restriction and have been withdrawn. Claims 5 and 7 have been amended. No new matter is added by these amendments. The Applicants respectfully submit that claims 2-11 are now in condition for allowance, which action is now requested. For this reason, and in view of the foregoing arguments, the Applicants believe that this application is now in condition for allowance, which action is earnestly solicited. Should there remain any unresolved issues, it is respectfully requested that the Examiner telephone Norma E. Henderson, Applicants' Attorney, at 603-437-4400, so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,



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